

COPY

Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed June 2, 2004.

Claims 1-27, 33-35 and 47 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 1-27, 33-35 and 47. The present Response adds claim 48. Claims 1-27, 33-35, and 47-48 are currently pending.

I. Summary of Office Action

Claims 1-3, 5-10 and 15-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohkado*, (U.S. Patent No. 6,542,165). Claims 22-25 and 27 were rejected for similar reasons.

Claims 4 and 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohkado* in view of *England* (U.S. Patent No. 6,144,991).

Claims 26 and 33-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohkado* in view of *Gutfreund et al.* (U.S. Patent No. 6,192,394).

Claims 21 and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohkado* in view of *Varma et al.* (U.S. Patent No. 6,564,246).

II. Summary of Response

Applicants have added claim 48. Applicants respectfully traverse the rejections.

III. Response

Claim 1, recites,

COPY

A system for placing and maintaining anchored conversations within an artifact comprising a *file having a file type*, the system comprising:
 an application configured to access the artifact, wherein the application is *associated with the file type*;
 a conversation client configured to access said anchored conversation and to receive communications regarding a portion of the artifact, *while the artifact is viewed within the application*;

The present invention discloses a system whereby users are able to engage in conversations anchored to locations within commonly viewed files. These files are viewed from their native applications on the system of each user. The claimed system is especially efficient as it utilizes the file viewing capacities of applications associated with the file. For example, a Microsoft Excel document could be viewed from the Microsoft Excel application on the user's system.

Ohkado, which discloses a system of collaborative image generation programs, does not disclose or suggest the features of the claimed invention. *Ohkado* does not disclose the collective accessing and conversing about files. Rather *Ohkado* discloses a system for highlighting physical sections of a viewing window so that the sections can be viewed on other systems. The annotations of *Ohkado* are not associated with the files themselves, but rather the raw images that are transmitted, as indicated in col3 ln. 20-24 "a step of sending image data of said application window".

Specifically, *Ohkado* does not disclose a "an application configured to access the artifact, wherein the application is *associated with the file type*". The Examiner, in providing his rejection, cites a section of *Ohkado*, which refers to a "subject application" from which the image data is originally extracted. Applicants, respectfully submit that the disclosure of this section is different from the claimed feature. The "subject application" of *Ohkado* is a source application from which image data is extracted. This application does not access the artifact, insofar as the artifact is defined in the previous limitation as being the item upon which the annotated conversations are presented. *Ohkado* discloses a system whereby image data is extracted from the disclosed "subject application" and passed to a conversation client for annotation with conversational content. The application of *Ohkado* does not perform any of the recited features (annotation, etc.)

Similarly, *Ohkado* does not disclose an artifact comprising a file having a file type. The artifacts of *Ohkado* are raw image data, rather than files associated with particular applications. The approach of *Ohkado* is distinctly inferior as the disclosed text communications are not associated

COPY

with artifacts documents, but rather raw images highlighted within a user's desktop. Furthermore, *Ohkado* depends on the capacity of the receiving client to receive raw image files.

Claim 3, in addition to the limitations of claim 1, additionally recites that the conversation element is configured to allow access to sections of the artifact outside the anchor. *Ohkado* is manifestly deficient of this feature. The section of *Ohkado* cited by the Examiner discloses the accessing of conversation content, not sections of the file outside the shared space. Indeed the system of *Ohkado* cannot allow access to sections of the application outside the anchor, because the system of *Ohkado*, rather than utilizing a shared chat space that is anchored to a section of a file, transmits raw graphical information to the other clients.

Claim 5 recites the creation of a recipient conversation having an anchor, application, and artifact that are equivalent to the artifact, anchor, and application the requesting conversation client. *Ohkado* fails to disclose or suggest this feature. Claim 1 recites that the artifact is a file having a file type. Thus claim 5, when taken with the limitations of claim 1, recites that the recipient conversation includes an artifact that is a file having a file type, equivalent to the one on the initiating conversation client.

However, the remote parties discussed in *Ohkado* *cannot* view an original or copy of the remote source file, as the system of *Ohkado* only transmits raw images from sections of the source file. As discussed in the cited section "a second display apparatus for displaying image data of said first application window". Thus, it is impossible for a conversation recipient in *Ohkado* to have an artifact equivalent to the artifact of the requesting conversation client, as the system of *Ohkado* does not provide access to files, only to raw image data extracted from the file.

Claim 48, in addition to the patentable subject matter of the other independent claims, additionally recites that communications are received by parties having access to the file. *Ohkado* is deficient of any mention of this feature and as discussed above, such functionality is incompatible with the system of *Ohkado*, as remote parties are only given access to image slices extracted from the application.

Claims 4 and 11-14, 26 and 33-35, and 21 and 47 were rejected over *Ohkado* in view of England, Gutfreund, and Varma respectively. With respect to these rejections, the Examiner cites no motivation to combine the references. The Examiner provides a *benefit* for combining the references,

COPY

but demonstrates no motivation, either explicit or implicit in either reference for combining them. The Federal Circuit has stated "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious *unless the prior art suggested the desirability of the modification.....* it is impermissible to use the claimed invention to piece together the prior art so that the claimed invention is rendered obvious". *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992)

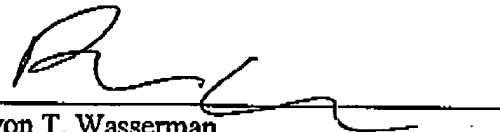
The references cited by the Examiner, but not relied, upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. §1.136 for extending the time to respond up to and including October 4, 2004.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: October 4, 2004 By: 
Bryon T. Wasserman
Reg. No. 48,404

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800
Fax: (415) 362-2928
Customer No.: 23910

- 13 -

Attorney Docket No.: FX/99006
BWasserman/fxpl/1000us0/1000US0.RESPC.DOC

FXPL-01000US0 MCF/BTW